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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/600,277	07/14/2000	KLAUS-DIETER HAMMER	051009/0125	1514

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3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER
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SIMONE, CATHERINE A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 04/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-11

**Office Action Summary**

Application No.

09/600,277

Applicant(s)

HAMMER ET AL.

Examiner

Catherine Simone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 January 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 13-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 13,17-30 and 35-41** are rejected under 35 U.S.C. 103(a) as being obvious over Hammer et al. (5,928,737) in view of Pophusen et al. (5,928,739).

Hammer et al. discloses a seamless, tubular food casing which is blown in an area ratio from 1:2 to 1:10 (see col. 2, lines 19-23), produced from a thermoplastic mixture which comprises a) thermoplastic starch (see col. 2, lines 16-18) and b) at least one other polymer (see col. 3, lines 49-54). However, Hammer et al. fails to disclose the polymer consisting of a polyesterurethane. Pophusen et al. teaches in the analogous art a polymer consisting of a polyesterurethane (see col. 3, lines 23-25) for the purpose of producing a food casing.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided a polyesterurethane in Hammer et al. as suggested by Pophusen et al. in order to produce a food casing.

Regarding **claims 18 and 19**, the weight ratio a:b appears to be in the range from 20:80 to 80:20 and in the range 40:60 to 60:40 (see col. 3, lines 54-56). Regarding claim 20 and 21, note plasticizer (see col. 3, lines 1-4) and a weight percent being up to 30% (see col. 3, lines 8-19).

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Regarding claim 22, note the proportion of plasticizer present in the thermoplastic mixture is up to 15% by weight (see col. 3, lines 8-19). ). Regarding **claim 23** and **24**, note one lubricant (see col. 3, lines 64-67) and a weight percent being up to 12% (see col. 4, lines 3-5). Regarding **claims 25** and **26**, note the proportion of lubricant present in the thermoplastic mixture is from 2 to 6% by weight based on the total weight of the thermoplastic mixture (see col. 4, lines 3-5). Regarding **claim 27** and **28**, note the thermoplastic mixture is mixed with fibers (see col. 3, lines 42-45) and a weight percent being up to 25% (see col. 3, lines 44-47). Regarding **claims 29** and **30**, note the proportion of fibers present in the mixture is from 2 to 15% by weight based on the total weight of the mixture (see col. 3, lines 44-47). Regarding **claims 35** and **36**, note crosslinker (see col. 3, lines 60-63) and a weight percent being up to 20% (see col. 3, lines 34-36 and 58-61). Regarding **claims 37** and **38**, note the crosslinker present in the thermoplastic mixture is from 0.5 to 10% by weight based on the total weight of the mixture (see col. 3, lines 58-61).

In regards to **claims 39** and **40**, process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

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Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitations “an internal preparation and/or external preparation” (**claim 39**) and “extruding the thermoplastic mixture through an annular die and blowing it in an area ratio of from 1:2 to 1:10” (**claim 40**) are methods of production and therefore do not determine the patentability of the product itself.

3. **Claims 14-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hammer et al. (5,928,737) in view of Bengs et al. (6,406,530).

Hammer et al. discloses a seamless, tubular food casing which is blown in an area ratio from 1:2 to 1:10 (see col. 2, lines 19-23), produced from a thermoplastic mixture which comprises a) thermoplastic starch (see col. 2, lines 16-18) and b) at least one other polymer (see col. 3, lines 49-54). However, Hammer et al. fails to disclose a starch ester comprising a starch acetate. Bengs et al. teaches a starch ester comprising a starch acetate (see col. 6, lines 8-13) in the analogous art for the purpose of making a thermoplastic mixture to produce a food casing.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided a starch ester comprising a starch acetate in Hammer et al. as suggested by Bengs et al. in order to make a thermoplastic mixture to produce a food casing.

4. **Claims 31-34** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hammer et al. (5,928,737) in view of Andra et al. (4,410,011).

Hammer et al. discloses a seamless, tubular food casing which is blown in an area ratio from 1:2 to 1:10 (see col. 2, lines 19-23), produced from a thermoplastic mixture which comprises a) thermoplastic starch (see col. 2, lines 16-18) and b) at least one other polymer (col. 3, lines 49-52). However, Hammer et al. fails to disclose fillers. Andra et al. teaches that it is known in the art to have fillers (see col. 13, lines 40-44) for the purpose of producing a tubular food casing.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided fillers in Hammer et al. as suggested by Andra et al. in order to produce a tubular food casing.

#### ***Response to Arguments***

5. Applicant's arguments filed January 27, 2003 have been fully considered but they are not persuasive. Applicant states "Applicants submit that Hammer fails to teach or fairly suggest a food casing produced from a) thermoplastic starch, a thermoplastic starch derivative or a mixture thereof and b) the specifically claimed polymers with "a weight ratio of a):b:) being in the range from 90:10 to 10:90" as set forth in claim 13. Pophusen adds nothing to resolve this deficiency in Hammer. Thus, neither Hammer nor Pophusen, taken either individually or in combination, teach or properly suggest a food casing produced from a) thermoplastic starch, a thermoplastic starch derivative or a mixture thereof and b) the specifically claimed polymers with a "weight ratio of a):b:) being in a range from 90:10 to 10:90" as set forth in claim 13." However, Hammer teaches a food casing produced from a) a thermoplastic starch (see col. 3, line 11) and b) a polymer with a weight ratio of a):b:) being in a range from 90:10 to 10:90 (see col. 3, lines 54-56). However,

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Hammer fails to teach the polymer being selected from the group as recited in claim 13.

Pophusen teaches it is old and well-known in the analogous art to have a food casing containing a polyesterurethane (see col. 3, line 25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have the polymer in Hammer et al. consist of polyesterurethane as suggested by Pophusen et al. in order to produce a food casing produced from a) thermoplastic starch, a thermoplastic starch derivative or a mixture thereof and b) a specifically claimed polymer with a "weight ratio of a):b:) being in a range from 90:10 to 10:90" as set forth in claim 13.

Regarding claims 31-34, Applicant states that "A person of ordinary skill in the art of making food casings thus would not have found any motivation to employ the fillers as taught by Andra in the seamless sausage casing of Hammer since there is no need for such an adhesive." In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Andra merely is cited for teaching that it is old and well known to employ fillers (see col. 16, lines 20-23) for the purpose of producing a tubular food casing.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


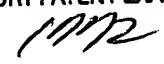
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (703) 605-4297. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Catherine Simone  
Examiner  
Art Unit 1772

April 3, 2003

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
 4/3/03